



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/028,997 | 12/20/2001 | Gregory J. Wolff | 015358-006800US | 3773 |

20350 7590 10/25/2007
TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

| |
|----------|
| EXAMINER |
|----------|

ROSARIO, DENNIS

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2624

| | |
|-----------|---------------|
| MAIL DATE | DELIVERY MODE |
|-----------|---------------|

10/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/028,997

Applicant(s)

WOLFF ET AL.

Examiner

Dennis Rosario

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-27 and 29-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-27 and 29-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>9/17/07</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment was received on 9/17/07. Claims 1,3-27 and 29-77 are pending.

Claim Objections

2. Claim 26 is objected to for the same reasons as the office action of 4/17/07.

Claim 17, line 13: "the first digital image" has no antecedent basis.

Response to Arguments

3. Applicant's arguments on page 23, 1st paragraph filed 9/17/07 have been fully considered but they are not persuasive and states:

"Applicants submit that Takahashi fails to teach at least (1) constructing, at the data processing system, one or more placement regions from the first digital image based upon features extracted from the first digital image by applying an image analysis technique to the first digital image to determine a first placement region on the first digital image for placing a second digital image, (2) constructing one or more placement regions ... wherein the location of the one or more placement regions is based upon the location of the features in the first digital image."

The examiner respectfully disagrees since Takahashi discloses:

(1) constructing (via fig. 15 to fig. 16 that has a constructed x-y axis while fig. 15 does not), at the data processing system (fig. 12, numerals 101,102,103), one or more placement regions (or a coordinate of the x-y axis) from the first digital image (fig. 15,num. 203) based upon features (such as fig. 15,num. 1401) extracted (via fig. 15,num. 1201) from the first digital image (fig. 15,num. 203) by applying an image analysis technique (as contemplated by a user and represented in fig. 15 as num. 1201) to the first digital image (fig. 15,num. 203) to determine a first placement region (or any coordinate of fig. 16 in the x-y coordinate system of fig. 16) on the first digital image (fig. 16,num. 203 is the same as fig. 15,num. 203) for placing a second digital image (fig. 16: IMAGE 2),

(2) constructing one or more placement regions (when comparing figure 15 to fig. 16 that has a constructed coordinate system where each coordinate of the coordinate system is a placement region) wherein the location of the one or more placement regions (of fig. 16) is based upon the location of the features in the first digital image (since both images of fig. 15 and fig. 16 are the same images; however, the image of fig. 16 is modified with a coordinate system)

4. Applicant's arguments on page 23, 2nd paragraph filed 9/17/07 have been fully considered but they are not persuasive and states:

“However, as described above, the creation of the print layout is a manual process and is not ‘performed at the data processing system’ as recited in claim 18.”

The examiner respectfully disagrees since the creation of the print layout (as represented in fig. 12 as numerals 101) is performed at the data processing system (fig. 12,numerals 101,102 and 103).

5. In response to applicant's argument on page 23,2nd paragraph that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., “...image analysis...is being applied **by** [emphasis added] ‘data processing system...’”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

6. Applicant's arguments on page 23, 3rd paragraph filed 9/17/07 have been fully considered but they are not persuasive and states:

"Takahashi also fails to teach at least 'constructing one or more placement regions ... wherein locations of the one or more placement regions are based upon locations of the features in the first digital image' as recited in claim 18."

The examiner respectfully disagrees since Takahashi discloses constructing one or more placement regions (as discussed in paragraph 3, above) wherein locations of the one or more placement regions are based upon locations or "position" in col. 12, line 23 of the features (or "handle 1401" in col. 12, line 24) in the first digital image (fig. 15,num. 203).

7. Applicant's arguments on page 24, with respect to Yamazaki filed 9/17/07 have been fully considered but they are not persuasive and states:

"Yamazaki fails to teach at least (1) constructing, at the data processing system, one or more placement regions from the first digital image based upon features extracted from the first digital image by applying an image analysis technique to the first digital image to determine a first placement region on the first digital image for placing a second digital image, (2) constructing one or more placement regions ... wherein the location of the one or more placement regions is based upon the location of the features in the first digital image."

The examiner respectfully disagrees since Yamazaki discloses:

(1) constructing, at the data processing system (fig. 2), one or more placement regions (one of which is shown in fig. 7A: IMAGE) from the first digital image (corresponding to an image in fig. 4,num. 150) based upon features extracted from the first digital image (since the image of fig. 4,num. 150 includes a barcode that is extracted in fig. 4,num. 170) by applying an image analysis technique (such as a user finding a "specific part of the sheet material with the 2D barcode" in col. 24, lines 53,54; thus, a user has to analyze the image for a specific part as opposed to other parts of the same image in order to obtain the bar code: note that the user performs the first image analysis and the system subsequently performs 2 more in fig. 4,numerals 150 and 172) to the first digital image (corresponding to fig. 4,num. 150) to determine a first placement region (said fig. 7A: IMAGE) on (or coded on) the first digital image (that includes said bar code) for placing a second digital image (or any one image of fig. 12C), and

(2) constructing one or more placement regions (one of which is shown in fig. 7A: IMAGE) wherein the location (fig. 7A: POSITION) of the one or more placement regions is based upon the locations (or "specific part of the sheet" in col. 24, lines 53,54 as opposed to other parts that are not specific) of the features (or said bar code and the image data) in the first digital image (that includes said image data and bar code).

8. Applicant's arguments on page 25, 3rd to last sentence, with respect to Yamazaki filed 9/17/07 have been fully considered but they are not persuasive and states:

“The locations of placements areas within the layout are not based upon ‘locations of the features [extracted from] the first digital image’ as recited in claim 18.”

The examiner respectfully disagrees since the locations of placements areas (one of which is shown in fig. 7A: IMAGE) within the layout are based upon locations (or “specific part of the sheet” in col. 24, lines 53,54 as opposed to other parts that are not specific) of the features (such as image data and a bar code) extracted (as done by a user that can read the image with the bar code and extract from reading the image which parts of the image are specific or not) from the first digital image (that includes said image data and bar code).

9. Applicant's arguments on page 25, 2nd to last sentence, with respect to Yamazaki filed 9/17/07 have been fully considered but they are not persuasive and states:

“Furthermore, even if the barcode were a ‘feature’ as recited in claim 18, the locations of placement areas on the layout are completely independent from the location of the barcode on the data input sheet.”

The examiner respectfully disagrees since a user has to find a specific part of the image meaning that the user has to find a specific part such as the center or upper left or upper right or bottom right or bottom left all of which are locations of the image that contains the barcode. If the bar code was not found by the user then layout processing such as locations of placement areas will not be possible since the barcode has layout information.

10. Applicant's arguments on page 26, 2nd paragraph, with respect to Yamazaki filed 9/17/07 have been fully considered but they are not persuasive and states:

“Applicants submit that Yamazaki fails to teach at least using the digital camera to capture a template image by selecting a button of the digital camera and using the digital camera to capture an image of the paper medium while the button of the digital camera is selected.”

The examiner respectfully disagrees since Yamazaki using the digital camera(fig. 1A) to capture a template image (fig. 7A) by selecting a button (fig. 1B,num. 28) of the digital camera and using the digital camera to capture an image of the paper medium (or “paper sheet” in col. 5, line 6) while the button (as implied by “extra operation buttons” in col. 4, lines 48,49) of the digital camera is selected (“during input of the predefined information” in col. 4, line 49). Thus, the single button of fig. 1B,num. 28 as opposed to extra operation buttons is used during input of the predefined information as shown in fig. 4 corresponds to the claimed “capture an image of the paper medium while the button of the digital camera is selected.”

11. In response to applicant's argument on page 26, last sentence that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "kept depressed") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

12. Applicant's arguments on page 27, 3rd paragraph, with respect to Simon filed 9/17/07 have been fully considered but they are not persuasive and states:

"Applicants submit that Simon fails to disclose at least (1) determining at the data processing system a template image from the plurality of digital images based upon a selection entered via the image capture device, (2) constructing one or more placement regions from the template image based upon features extracted from the template image, and (3) constructing one or more placement regions ... wherein locations of one or more placement regions are based upon locations of the features in the first digital image."

The examiner respectfully disagrees since Simon discloses:

(1) determining (fig. 5,num. 110) at the data processing system (fig. 1,num. 70) a template image (fig. 8,num 212) from the plurality of digital images (fig. 5,num. 100) based upon a selection entered via the image capture device (fig. 1,num. 20),

(2) constructing one or more placement regions from the template image based upon features extracted from the template image (as addressed in the office action of 4/17/07, paragraph 28), and

(3) constructing one or more placement regions (as addressed in the office action of 4/17/07, paragraph 28) wherein locations of one (such as said bottom most image in said paragraph 28) or more placement regions are based upon locations (during a REARRANGE operation in fig. 7,num. 220) of the features in the first digital image (fig. 8,num 212).

13. Applicant's arguments on page 28, 2nd paragraph have been fully considered but they are not persuasive and states:

“Simon does not use template images for determining a page layout”

The examiner respectfully while the examiner agrees with the above statement, Simon actually uses a page layout to determine a template see paragraph [0051] of Simon.

Art Unit: 2624

14. Applicant's arguments on page 29, 2nd paragraph have been fully considered but they are not persuasive and states:

"Applicants submit that Simon further fails to teach at least "placing a copy of a digital image from the plurality of digital images identified for the placement region in the placement region on the template image to generate the customized digital image" as recited in Applicants' claim 17 (emphasis added)."

The examiner respectfully disagrees for the same reasons as the office action of 4/17/07, paragraph 30.

15. Applicant's arguments on page 29, 2nd paragraph have been fully considered and is persuasive; however, the rejection can be maintained and states:

"The page layout in Simon is not a template image"

Upon further review the layout can be used to "store a template of the page layout" in [0051] of Simon upon the output of fig. 5, num. 160 were the template can be used as described in the prior art in [0004] and [0048].

Art Unit: 2624

16. Applicant's arguments on page 29, 2nd paragraph have been fully considered and is persuasive; however, the rejection can be maintained and states:

“Therefore, when the page layout subroutine of Simon determines a page layout for a set of images, it is not placing a copy of a digital image or images into a template image to create a composite image as recited in claim 17.”

The examiner respectfully disagrees since when the page layout subroutine of Simon determines a page layout (fig. 7,num. 200) for a set of images, it is placing a copy (as shown in fig. 4,num. 54 as compared to fig. 3,num. 54) of a digital image or images (fig. 3,numerals 54-62) into a template image (fig. 2,num. 41) to create a composite image (fig. 4,num. 41).

17. Applicant's arguments on page 30, 2nd paragraph have been fully considered but they are not persuasive and states:

“Applicants submit that Shaffer fails to teach at least (1) constructing, at the data processing system, one or more placement regions from the first digital image based upon features extracted from the first digital image, and (2) constructing placement regions ... wherein locations of the one or more placement regions are based upon locations of the features in the first digital image.”

The examiner respectfully disagrees since Shaffer discloses:

(1) constructing (see paragraphs 4-7 on the office action of 4/17/07), at the data processing system (fig. 4, all numerals), one or more placement regions from the first digital image based upon features extracted from the first digital image, and

(2) constructing placement regions (see paragraphs 4-7 on the office action of 4/17/07) wherein locations (such as “ ‘Where’ information” in col. 8, line 58) of the one or more placement regions are based upon locations (or “location scenes” in col. 8, line 63) of the features (or “image content” in col. 8, line 63) in the first digital image.

18. Applicant's arguments on page 30, 2nd paragraph have been fully considered but they are not persuasive and states:

"Applicants submit that Shaffer fails to teach 'constructing at the data processing system one or more placement regions from the first digital image based upon features extracted from the first digital image by applying an image analysis technique to the first digital image, each placement region of the one or more placement regions identifying a location on the first digital image for placing a digital image from a first set of digital images captured using the image capture device' as recited in claim 1."

The examiner respectfully disagrees for the same reasons as paragraph 16, above and in the office action of 4/17/07, paragraphs 4-7.

19. In response to applicant's argument on page 30, 2nd paragraph that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "performed by the data processing system") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

20. Applicant's arguments on page 30, 2nd paragraph have been fully considered but they are not persuasive and states:

“...nor is merely moving or deleting images from placement regions in predefined template ‘constructing ... one or more placement regions from the first digital image’ as recited in claim 1.”

The examiner respectfully disagrees since Shaffer discloses constructing one or more placement regions (or “generate annotation” in col. 8, line 33 about a “location” in col. 8, line 63) from the first digital image.

21. Applicant’s arguments, see page 32, with respect to the “barcode” have been fully considered and are persuasive; however, the rejection is maintained. See paragraph 19, above.

22. Applicant’s arguments on page 33, 3rd paragraph have been fully considered but they are not persuasive and states:

“Anderson fails to disclose constructing one or more placement regions from the first digital image as recited in claim [18].” Note that Anderson was used to reject claim 18 and not claim 1.

The examiner respectfully disagrees for the same reasons as the office action of 4/17/07, paragraph 34.

Art Unit: 2624

23. Applicant's arguments on page 34, 2nd paragraph have been fully considered but they are not persuasive and states:

“Applicants further submit that Anderson also fails to disclose ‘constructing one or more placement regions ... wherein locations of one or more placement regions are based upon locations of the features in the first digital image’ as recited in Applicants’ claim 1.”

The examiner respectfully disagree since Anderson does disclose constructing (via fig. 1,num. 108) one or more placement regions (as shown in fig. 2, num. 206) wherein locations of one or more placement regions are based upon locations of the features (or “position of the representation” in col. 3, line 50) in the first digital image (corresponding to the output of fig. 1,num. 106 so that the “user interface element [fig. 2,num. 206]...corresponds to the position of the representation” in col. 3, lines 50,51).

Claim Rejections - 35 USC § 102

24. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

25. Claim 18 is rejected under 35 U.S.C. 102(e) as being anticipated by Takahashi (US Patent 6,867,882 B1).

Regarding claim 18, Takahashi discloses a method of generating a customized digital image the method comprising:

a) receiving (via "print layout memory" in col. 12, line 34 that stores which is interpreted as receiving), at the data processing system (see paragraphs 3,4 and 5, above), a first digital image (fig. 15,num. 203) using an image capture device (fig. 12,num. 101) having a selectable mode (fig. 5, num. S11) for capturing (via "print layout memory" in col. 12, line 34 is interpreted as capturing since the memory stores which is also interpreted to mean capturing) a template image (as shown in fig. 16);

b) constructing, at the data processing system, one or more placement regions from the first digital image based upon features extracted from (see paragraphs 15-18 and 21 of the office action of 4/17/07) the first digital image by applying an image analysis technique to the first digital image (a user decides where to move the images and enlarge or reduce images via a pointer as shown in fig. 15,num. 1201) to determine a first placement region (fig. 16, label: IMAGE 2 was moved to a new location relative "IMAGE 2" of fig. 12) on the first digital image (fig. 16,num. 203) for placing a second digital image, wherein locations of the one or more placement regions are based upon locations of the features in the first digital image (see paragraphs 3 and 6, above); and

c) placing, at the data processing system, the second digital image (as shown in fig. 15, label: IMAGE 2) in the first placement region (as shown in fig. 2, label: IMAGE 2) on the first digital image (fig. 16,num. 203 is the same image as fig. 15,num. 203) to generate the customized digital image (as shown in fig. 20).

26. Claims 18,24,25 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamazaki (US Patent 6,999,117 B2).

Regarding claim 18, Yamazaki discloses a method of generating a customized digital image the method comprising:

a) receiving, at the data processing system (see paragraph 7, above), a first digital image (as shown in fig. 6B) using an image capture device (fig. 1A,num. 10) having a selectable mode (the output of fig. 3A,num. 100: INFORMATION INPUT MODE) for capturing a template image (as shown in fig. 7A);

b) constructing (see paragraph 7, above), at the data processing system, one or more placement regions (as shown in fig. 7A: IMAGE) from the first digital image based upon features extracted (as done in fig. 4, num. 170 and see paragraph 9, above) from the first digital image by applying an image analysis technique (as done in fig. 4,num. 172) to the first digital image to determine a first placement region on the first digital image for placing a second digital image , wherein locations of the one or more placement regions are based upon locations of the features in the first digital image (see paragraphs 7 and 8, above); and

c) placing (as indicated in fig. 7A: POSITION FOR SYNTHESIS OF DESIGNATED IMAGE), at the data processing system, the second digital image in the first placement region on the first digital image to generate the customized digital image (as shown in fig. 7A).

Regarding claim 24, Yamazaki discloses a method of generating a customized digital image using a digital camera, the method comprising:

- a) capturing one or more images using the digital camera with the digital camera in a first mode (fig. 9A: PHOTOGRAPH MODE);
- b) capturing a template image (fig. 7A) by imaging a paper medium (or "sheet of paper" in col. 38, lines 11,12) with the digital camera in a second mode (fig. 9A: INFORMATION INPUT MODE and see paragraphs 10,11, above);
- c) determining in the digital camera one or more placement regions (a shown in fig. 7A as IMAGE) from the template image, each placement region of the one or more placement regions identifying a location on the template image for placing an image from the one or more images captured using the digital camera;
- d) identifying in the digital camera, for each placement region of the one or more placement regions, an image (fig. 12D) from the one or more images (fig. 12C) to be placed in the placement region; and
- e) for each placement region of the one or more placement regions, placing a copy (as shown in the right side of fig. 12G that is a cropped version of the image of fig. 12D) of an image from the one or more images identified for the placement region in the placement region to generate the customized digital image (fig. 12G).

Claim 25 is rejected the same as claim 24. Thus, argument similar to that presented above for claim 24 is equally applicable to claim 25.

Art Unit: 2624

Regarding claim 26, Yamazaki discloses the method of claim 25 wherein using the digital camera to capture a template image further comprises:

a) imprinting the one or more bounded regions on a paper medium (as shown in fig. 7B that has bounded regions on a sheet of paper); and

b) using the digital camera to capture the one or more images (in PHOTOGRAPH MODE in fig. 9A) comprises:

b1) capturing the one or more images using the digital camera without selecting the button of the digital camera (see fig. 9A: since a PHOTOGRAPH MODE was selected instead of INFORMATION INPUT MODE or IMAGE PLAYBACK MODE).

27. Claims 17,45 and 71 are rejected under 35 U.S.C. 102(e) as being anticipated by Simon et al. (US Patent Application Publication No.: US 2002/0040375 A1 or serial number 09/825,453).

Regarding claim 17 Simon et al. discloses a method of generating a customized digital image, the method comprising:

a) receiving, at the data processing system (see paragraph 12, above), a signal (via the input of fig. 5,num. 110) comprising:

a1) digital signals representative of a plurality of digital images (as shown in fig. 5,num. 100), the plurality of digital images captured using an image capture device (fig. 1, num. 20 is interpreted as a capture device since num. 20 stores the images where the action of storing is interpreted to also mean capturing);

b) determining (see paragraph 12, above), at the data processing system, a template image (fig. 5,num. 160 and see paragraphs 13 and 15, above) from the plurality of digital images (fig. 5,num. 100) based upon a selection entered (at fig. 1,num. 110) via the image capture device (fig. 1, num. 20);

Art Unit: 2624

c) constructing (see paragraphs 26 and 28 of the office action of 4/17/07), at the data processing system, one or more placement regions (fig. 17,num. 286) from the template image based upon features extracted from the template image (see paragraph 28 above) by applying an image analysis technique (via the method of fig. 7) to the template image, each placement region of the one or more placement regions identifying a location on the template image for receiving a digital image (as shown in fig. 15,num. 60) from the plurality of digital images captured by the image capture device, wherein locations of the one or more placement regions are based upon locations of the features in the first digital image (see paragraph 12, above);

d) identifying, at the data processing system, for each placement region of the one or more placement regions, a digital image from the plurality of digital images to be placed in the placement region (as shown in fig. 15,num. 60); and

e) for each placement region of the one or more placement regions, placing a copy (Fig. 13,num. 62 is a copy relative to fig. 11,num. 62 and see paragraphs 14 and 16, above) of a digital image from the plurality of digital images identified for the placement region in the placement region on the template image (see paragraph 30 of the office action of 4/17/07) to generate the customized digital image (as shown in fig. 13) at the data processing system.

Claim 45 is rejected the same as claim 17. Thus, argument similar to that presented above for claim 17 is equally applicable to claim 45 except for the limitation of:

- a) a processor (fig. 8,num. 802); and
- b) a memory (fig. 8,num. 804) coupled to the processor.

Claim 71 is rejected the same as claim 17. Thus, argument similar to that presented above for claim 17 is equally applicable to claim 71 except for the additional limitation disclosed in Simon et al. of a computer program product (fig. 1,num. 20).

Art Unit: 2624

28. Claims 1,3-5,7-16,19-22,27,29-31,33-44,46-50,52,54-60,62-70 and 72-76 are rejected under 35 U.S.C. 102(e) as being anticipated by Shaffer et al. (US Patent 6,396,963 B2).

Regarding claim 1, Shaffer et al. discloses a method of generating a customized digital image, the method comprising:

a) receiving, at the data processing system (see paragraphs 17, 19 and 21 above), a first digital image (via the inputs of fig. 7, num. 152) from an image capture device (or scanner of fig. 7,num. 157), the first digital image designated as a template image using the capture device (see paragraph 3 above) having a selector for identifying the first digital image as a template image (fig. 9,num. 164 is interpreted as a selector for identifying. Since the scanner of fig. 7,num. 157 scans the sheet of fig. 9,num. 160 the scanner is inputting or having a selector or identifier as shown in fig. 9,num. 164 that is used to identify the first digital image as shown in fig. 9,num. 160 after scanning. Note that the claimed selector is interpreted to perform the action of identifying and not selecting.);

Art Unit: 2624

b) constructing (see paragraphs 4-7 of the office action of 4/17/07 and 17 and 18, above), at the data processing system, one or more placement regions (fig. 9 shows at the top left one placement region or the smaller rectangle enclosed by a larger rectangle and see paragraph 20,above) from the first digital image (top left larger rectangle) based upon features extracted from the first digital image (see paragraphs 6 and 7 above) by applying an image analysis technique ("pattern recognition" in col. 13, line 13) to the first digital image, each placement region of the one or more placement regions identifying a location on the first digital image for placing a digital image from a first set of digital images (one image from fig. 7, num. 45) captured using the image capture device , wherein locations of the one or more placement regions are based upon locations of the features in the first digital image (see paragraph 17, above);

c) identifying (via fig. 7,num. 149),at the data processing system, for each placement region of the one or more placement regions, a digital image from the first set of digital images to be placed in the placement region; and

d) for each placement region of the one or more placement regions, placing at the data processing system a digital image (via fig. 6, label: "If new template, place proper picture into template." Note that fig. 6 is a digital version; thus all processing of figure 6 is digital.) from the first set of digital images identified (via fig. 7, num. 149) for the placement region (or layout of fig. 7,num. 157) in the placement region on the first digital image (see paragraph 8 above) to generate the customized digital image (the output of fig. 7,num. 157).

Regarding claim 3, Shaffer et al. discloses the method of claim 1 further comprising:

- a) creating a link (or "list of images" in col. 13, line 22) between the customized digital image and at least one digital image ("high resolution image" in col. 13, line 23) from a second set of digital images (or "image storage" in col. 13, line 24), wherein the link enables access to the at least one digital image from the second set of digital images using the customized digital image (or "scanned layout sheets" in col. 13, line 26).

Claim 4 is rejected the same as claim 3. Thus, argument similar to that presented above for claim 3 is equally applicable to claim 4 except for requiring the limitation of a user as disclosed in Shaffer et al. via a "Customer" in fig. 7,num. 14.

Regarding claim 5, Shaffer et al. discloses the method of claim 1 wherein receiving the first digital image comprises:

- a) scanning, using the image capture device, a paper medium on which the one or more placement region have been indicated to generate the first digital image (via the last step of fig. 5 (Analog version)).

Regarding claim 7, Shaffer et al. discloses the method of claim 1 wherein the extracted features include one or more bounded regions (as shown by the smaller rectangles of fig. 9).

Regarding claim 8, Shaffer et al. discloses the method of claim 1 wherein extracted features include one or more text fragments (fig. 8, num. 119 or fig. 9.num. 164).

Claim 9 is rejected the same as claim 8. Thus, argument similar to that presented above for claim 8 is equally applicable to claim 9.

Regarding claim 10, Shaffer et al. teaches the method of claim 1 wherein identifying, for each placement region of the one or more placement regions, a digital image from the first set of digital images to be placed in the placement region comprises:

- a) determining image identification information (via "pattern recognition" in col. 13, line 13) associated with at least a first placement region of the one or more placement regions from the first digital image, the image identification information identifying an attribute ("embedded...data" in col. 12, lines 63,64) of a digital image to be placed in the at least first placement region;

- b) identifying a first digital image from the first set of digital images to be placed in the at least first placement region based upon the image identification information (or "image identification" in col. 13, line 21) associated with the at least first placement region (via "image stickers" in col. 12, lines 61,62 that was placed in any one rectangle of fig. 9.).

Claim 11 is rejected the same as claim 10. Thus, argument similar to that presented above for claim 10 is equally applicable to claim 11.

Claim 12 is rejected the same as claim 10. Thus, argument similar to that presented above for claim 10 is equally applicable to claim 12 except for the additional limitation of a time stamp which is disclosed in Shaffer et al. in col. 11, line 66: "data and time" or "image identification" in col. 12, line 18 which is used for embedding into an image in col. 12, line 18-21.

Regarding claim 13, Shaffer et al. discloses the method of claim 1 wherein placing a digital image from the first set of digital images identified for the placement region in the placement region to generate the customized digital image comprises:

- a) adjusting (or "zoom and crop" in col. 13, line 32) the digital image to fit the placement region.

Claim 14,15 and 16 are rejected the same as claim 13. Thus, argument similar to that presented above for claim 13 is equally applicable to claims 14,15 and 16.

Claims 19 and 20 are rejected the same as claim 3. Thus, argument similar to that presented above for claim 3 is equally applicable to claims 19 and 20.

Claims 21 and 22 are rejected the same as claims 4 and 5. Thus, argument similar to that presented above for claims 4 and 5 is equally applicable to claims 21 and 22.

Claim 27 are rejected the same as claim 1. Thus, argument similar to that presented above for claim 1 is equally applicable to claim 27 except for the additional limitation disclosed in Shaffer et al.:

- a) an input module (the inputs of fig. 7,num. 152);
- b) a processing module (fig. 7,num. 152);
- c) wherein the input module is configured to receive a first digital image captured with an image capture device (via a scanner of fig. 7,num. 157); and
- d) wherein the processing module is configured to perform the method of claim 1, addressed above.

Claims 29-31 and 33-42 are rejected the same as claims 3-5 and 7-16, respectively. Thus, argument similar to that presented above for claims 3-5 and 7-16 is equally applicable to claims 29-31 and 33-42, respectively.

Regarding claim 43, Shaffer et al. discloses a digital camera ("digital camera" in col. 13, line 37) that incorporates the system of claim 27.

Regarding claim 44, Shaffer et al. discloses a copying machine (or scanner of fig. 7,num. 157) that incorporates the system of claim 27.

Claim 46 is rejected the same as claim 1. Thus, argument similar to that presented above for claim 1 is equally applicable to claim 46 except for the additional limitation disclosed in Shaffer et al.:

- a) a processor (fig. 4,num. 94); and
- b) a memory (fig. 4,num. 102) for storing a program;
- c) wherein the processor is operative with the program to:
 - c1) receive a first digital image; and
 - c2) receive a second digital image (via fig. 4,num. 104).

Claims 47-50 are rejected the same as claims 19-22. Thus, argument similar to that presented above for claims 19-22 is equally applicable to claims 47-50.

Claims 52 and 54 are rejected the same as claim 46. Thus, argument similar to that presented above for claim 46 is equally applicable to claims 52 and 54.

Claims 55 and 56 are rejected the same as claims 43 and 44. Thus, argument similar to that presented above for claims 43 and 44 is equally applicable to claims 55 and 56.

Claim 57 is rejected the same as claim 1. Thus, argument similar to that presented above for claim 1 is equally applicable to claim 57 except for the additional limitation as disclosed in Shaffer et al. of a computer program product (fig. 4,num. 102).

Claims 58-60 and 62-67 are rejected the same as claims 3-5 and 7-12, respectively. Thus, argument similar to that presented above for claims 3-5 and 7-12 is equally applicable to claims 58-60 and 62-67, respectively.

Claim 68 is rejected the same as claims 13 and 16. Thus, argument similar to that presented above for claims 13 and 16 is equally applicable to claim 68.

Claims 69 and 70 are rejected the same as claims 14 and 15. Thus, argument similar to that presented above for claims 14 and 15 is equally applicable to claims 69 and 70.

Claim 72 is rejected the same as claim 57. Thus, argument similar to that presented above for claim 57 is equally applicable to claim 72.

Claims 73-76 are rejected the same as claims 19-22. Thus, argument similar to that presented above for claims 19-22 is equally applicable to claims 73-76.

Claim Rejections - 35 USC § 103

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

30. Claims 6,23,32,51,61 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al. (US Patent 6,396,963 B2) in view of Anderson (US Patent 6,690,396 B1).

Regarding claim 6, Shaffer et al. does not teach photographing a paper medium to generate the claimed first digital image, but does teach two methods (figures 5 and 6) of generating the claimed first digital image. Thus, Shaffer et al. suggests that there is a plurality of methods that can be used to generate the claimed first digital image.

Anderson et al. teaches another method of creating the claimed first digital image as shown in figure 2 and the additional limitation of:

a) photographing (via a "CCD...[or]...capture device" in col. 9, lines 65-67), using the image capture device, a paper medium (or "TANGIBLE MEDIUM" of fig. 1,num. 102) on which the one or more placement regions have been indicated (as shown in fig. 2,num. 204) to generate the first digital image (fig. 2,num. 202).

It would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Shaffer et al.'s two methods of figure 5 and 6 to generate the claimed first digital image with Anderson et al.'s teaching of using a CCD or capture device, because Anderson et al.'s teaching does not limit the types of devices and provides a plurality of devices for generating the claimed first digital image.

Claims 23,32,51,61 and 77 are rejected the same as claim 6. Thus, argument similar to that presented above for claim 6 is equally applicable to claims 23,32,51,61 and 77.

31. Claims 18-23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson (US Patent 6,690,396 B1) in view of Takahashi (US Patent 6,867,882 B1).

Regarding claim 18, Anderson teaches a method of generating a customized digital image, the method comprising:

a) receiving, at the data processing system, a first digital image (via the input of fig. 1,num. 106 as shown in fig. 2 via output arrow of fig. 1,num. 104) using an image capture device (fig. 8,num. 818) having a selectable mode for capturing a template image;

b) constructing , at the data processing system, one or more placement regions from the first digital image (see paragraph 22, above) based upon features extracted from (see paragraph 34 above) the first digital image (Fig. 1, num. 106) by applying an image analysis technique (or "correlation" in col. 3, line 46 that identifies features, fig. 2, numerals 204-216.) to the first digital image to determine a first placement region (fig. 2,num. 204) on the first digital image for placing a second digital image ("3 X 5 PHOTOGRAPH" in fig. 2,num. 204 after scanning), wherein locations of the one or more placement regions are based upon locations of the features in the first digital image (see paragraph 23, above);

c) placing , at the data processing system, the second digital image in the first placement region on the first digital image (fig. 3, num. 312 via a format operation) to generate the customized digital image (as shown in fig. 4,num. 402 and see paragraph 36 above).

Anderson does not teach the claimed having a selectable mode for capturing a template image. However, Anderson does suggest that a plurality of capture devices can be used as shown in fig. 8, numerals 818,820 and 822.

Takahashi teaches one such image capture device as shown in fig. 21,num. 101 that can be used with Anderson's fig. 8, numerals 818,820 and 822 and the remaining limitation of:

a) an image capture device (fig. 21,num. 101) having a selectable mode (fig. 24, num. S81) for capturing a template image (as done in fig. 26,num. S105 that stores a "PRINT IMAGE" shown and described in fig. 26,num. S105 that includes a "TEMPLATE IMAGE" shown and described in fig. 26,num. S105).

It would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Anderson's teaching of using a plurality of image capture devices with Takahashi's image capture device that enables "image process operations [that] become easy and convenient for the user" in col. 15, lines 59,60.

Regarding claim 19, Anderson discloses the method of claim 18 wherein the second digital image is a copy (or "thumbnail" in col. 5, line 58) of a third digital image (or "expanded view" in col. 5, line 58).

Claims 20 and 21 are rejected the same as claim 19. Thus, argument similar to that presented above for claim 19 is equally applicable to claims 20 and 21.

Regarding claim 22 see figure 1, numerals 102 and 104.

Regarding claim 23, Anderson discloses a "CCD" in col. 9, line 65.

32. Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al. (US Patent 6,396,963 B2) in view of Takahashi (US Patent 6,867,882 B1).

Regarding claim 53, Shaffer et al. does not teach the limitations of claim 53 with respect to said digital camera; however, Shaffer et al. suggests to one of ordinary skill in the art that a plurality of image capture devices can be used as shown in fig. 2, numerals 8,12,10 and 6.

Takahashi teaches one such image capture device as shown in fig. 13,num. 101 and the remaining limitations of claim 53 of:

a) a first button (fig. 13,num. 206) which when selected indicates (via a screen as shown in fig 13,num. 203) that an image received by the digital camera is a template image (as shown in fig. 15).

It would have been obvious at the time the invention was made to one of ordinary skill in the art to modify Shaffer et al.'s teaching of using a plurality of image capture devices with Takahashi's image capture device that enables "image process operations [that] become easy and convenient for the user" in col. 15, lines 59,60.

Conclusion

33. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ito et al. (US Patent 6,222,637 B1) is pertinent as creating a mask as shown in fig. 19B that defines positions for a template as described in fig. 19c as POSITIONAL INFORMATION.

Itoh (US Patent 6,034,785) is pertinent as teaching a template coordinate system as shown in fig. 5.

Fredlund et al. (US Patent 5,815,645) is pertinent as teaching a method of using a "predetermined location (abstract)" as shown in fig. 2,numerals 102,10 and 106 for placing an images as shown in figures 3a-3c.

34. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

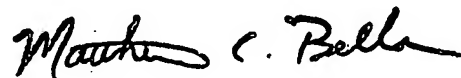
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Rosario whose telephone number is (571) 272-7397. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Bella can be reached on (571) 272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

D12
Dennis Rosario
Unit 2624



MATTHEW C. BELLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600